

**REMARKS/ARGUMENTS**

Claims 1-30 and 46-59 are currently pending in the above-identified application. Claims 1, 13, 14, 26, 27, 46, and 55-57 have been amended as set forth in the above listing of the claims. The amendments are supported throughout the specification, including, for example, at page 8, lines 24-31, and Figure 2. As such, no new matter has been added by these amendments. Applicants respectfully request reexamination and reconsideration of all pending claims.

**Claim Objection under 37 C.F.R. § 1.75(c)**

Claims 26-27 and 55-57 are objected to under 37 C.F.R. § 1.75(c) as being in improper multiple dependent claim form. The claims have been amended to refer to other claims in the alternative. Accordingly, withdrawal of the objection is respectfully requested.

**Claim rejections under 35 U.S.C. § 112**

Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention. In particular, it is stated in the Office action that the term "the coordinator" lacks sufficient antecedent basis. The claim has been amended to recite the term "a coordinator". Accordingly, removal of the rejection is respectfully requested.

**Claim rejections under 35 U.S.C. § 101**

Claims 1-25, 28-30, 46-54 and 58-59 are rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter. The rejection is traversed in part and overcome in part.

It is stated in the Office action that the steps of the claims can be performed in the mind of the user or by use of a pencil and paper because the claims fail to apply, involve, use, or advance the technological arts. Although Applicants respectfully disagree with the rejection, claims 1, 14, and 46 have been amended in order to expedite prosecution, thereby obviating the rejection of the claims as allegedly being drawn to non-statutory subject matter. Claim 1 has been amended to include "accessing an electronic database having information comprising a

number of procedures performed by each of the group of certified practitioners" and "providing to the identified individual patients a list of certified practitioners, selected from the electronic database..." Claim 14 includes "accessing an electronic database having information comprising performance criteria for each of the group of certified dental practitioners; and "providing to the identified patients referral lists of certified practitioners, selected from the electronic database..." Claim 46 includes "maintaining a patient referral directory in an electronic database having information comprising a number of procedures performed by each of the certified practitioners, wherein certified practitioners selected from the electronic database are prioritized on a list based on the number of times each certified practitioner has performed the procedure." As such, the current claims are directed to methods utilizing the technological arts and, therefore, are directed to statutory subject matter. Accordingly, withdrawal of the rejection is respectfully requested.

**Claim rejections under 35 U.S.C. § 103**

The rejection of claims 1-5 and 12-13 under 35 U.S.C. § 103(a), as being unpatentable over DeBruin-Ashton (U.S. Patent No. 6,014,629) in view of Falchuk *et al.* (U.S. Publication No. 2002/0152096 A1), is respectfully traversed.

Applicants respectfully disagree with the Examiner's analysis of DeBruin-Ashton. In particular, DeBruin-Ashton fails to teach providing to identified individual patients a list of certified practitioners, selected from an electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list. Thus, the cited references fail to teach or suggest each and every element of the claims, which is required to establish a prima facie case of obviousness. See, e.g., MPEP § 2143.

The DeBruin-Ashton reference is directed to a directory system with which customers can select physicians having specialties that correspond to the health care needs of the customer. DeBruin-Ashton teaches selecting physicians based on broad specialty categories (e.g., pediatrics for customers having children, gastroenterology for customers who are over 60 years old, etc.) and then reducing the number of physicians originally selected in order to present a more manageable list for a customer. For example, the methods of DeBruin-Ashton include randomly removing physicians from the list in order to reduce the list to a pre-selected number of

physicians (see, e.g., col. 12, lines 43-47). The DeBruin-Ashton disclosure is silent, however, with respect to listing physicians preferentially based on the number of times a particular procedure has been performed.

The Examiner alleges that DeBruin-Ashton's use of "other selection algorithms" is equivalent to placing practitioners preferentially on a list based on the number of performed procedures (col. 12, lines 47-54). However, the only "other selection algorithm" taught by DeBruin-Ashton consists of representing physicians who have newly joined the health care plan in a higher proportion than physicians that have been with the health care service for an extended period of time (see, e.g., col. 12, lines 47-54). Applicants point out that this is distinctly different from the current disclosure and, in fact, produces a result opposite that currently disclosed, which is to refer patients to practitioners who have more experience and are likely more efficient in performing the medical procedure for which they have been certified (see, e.g., page 8, line 34 to page 9, line 2). Nowhere does DeBruin-Ashton teach listing physicians preferentially based on the number of times a particular procedure has been performed, as required in the current claims.

It is further alleged that Falchuk teaches certifying a group of practitioners to perform a medical procedure, and that it would have been obvious to combine the teachings of DeBruin-Ashton with Falchuk to produce the method of claim 1. Applicants respectfully disagree.

Falchuk teaches a medical consultation support system designed to direct primary care physicians to specialist physicians, for the purpose of consultation related to a given medical condition of a patient. The Examiner alleges that the "accreditation" taught at paragraphs 0021 and 0030 of Falchuk are equivalent to the "certifying" step of the current claims. Applicants point out, however, that the teachings of Falchuk are limited to the awarding of continuing medical education (CME) credit for general medical education purposes. In particular, the "accreditation module" taught by Falchuk concerns recording and reporting of CME credits to a responsible accreditation authority (e.g., state medical board), based on the educational value, to the primary care physician, of the consultation with a specialist physician. While CME credits may be necessary for a physician to maintain an active medical license, the awarding of CME credits by consultation of a primary care physician with a specialist physician, as taught by

Falchuk, distinctly differs from the certifying of a group of practitioners to perform a particular medical procedure, as required by the current claims. As such, Falchuk fails to teach certifying a group of practitioners to perform a medical procedure, as recited in current claim 1.

In summary, neither DeBruin-Ashton nor Falchuk, alone or in combination teach each and every element of the current claims. In particular, the references fail to teach listing physicians preferentially based on the number of times a particular procedure has been performed; and certifying a group of practitioners to perform a medical procedure. The failure to teach those elements, which are recited in independent claim 1 and incorporated into the corresponding dependent claims, precludes establishment of *prima facie* obviousness. Accordingly, removal of the rejection of claims 1-5 and 12-13 under 35 U.S.C. § 103(a) is respectfully requested.

Claims 6-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DeBruin-Ashton (U.S. Patent No. 6,014,629) in view of Falchuk *et al.* (U.S. Publication No. 2002/0152096 A1) as applied to claim 1 above, in view of Tawil (U.S. Patent No. 5,225,976), and further in view of Kurzuis *et al.* (U.S. Patent No. 6,385,620 B1). Applicants respectfully traverse.

As discussed above, the combined DeBruin-Ashton and Falchuk references fail to teach each and every element of claim 1 and, therefore, corresponding dependent claims. For example, DeBruin-Ashton fails to teach providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list. Falchuk fails to teach certifying a group of practitioners to perform a medical procedure.

The Tawil reference is cited by the Examiner as allegedly teaching tracking the number of times the procedure has been performed. Kurzuis is cited as allegedly teaching placing candidates into tiers based on experience and proficiency level. Applicants point out, however, that Tawil is directed to a health benefit processing system designed to process health benefits claims for insurance purposes, which is distinguished from the current disclosure. The entire Kurzuis disclosure is directed to employment candidate recruiting and is silent with

respect to referring patients to medical practitioners. It is submitted that neither Tawil nor Kurzius provide the teachings that are missing from DeBruin-Ashton and Falchuk. Thus, even if one of ordinary skill were motivated to combine the cited references, the combination of DeBruin-Ashton, Falchuk, Tawil, and Kurzius would fail to teach each and every element of the current claims, thereby precluding a finding of *prima facie* obviousness.

Accordingly, for the reasons set forth above, removal of the rejection of Claims 6-11 under 35 U.S.C. § 103(a) is respectfully requested.

Claims 14, 16-19, 21-22 and 29-30 are rejected under 35 U.S.C § 103(a) as being unpatentable over DeBruin-Ashton (U.S. Patent No. 6,014,629) in view of Joao (U.S. Publication No. 2002/0032583 A1). Applicants respectfully traverse.

Applicants submit that the cited references fail to teach each and every limitation of the claimed invention, thereby precluding a finding of *prima facie* obviousness. As discussed above, DeBruin-Ashton fails to teach providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list.

Joao does not teach certifying dental practitioners to perform a dental procedure, as alleged by the Examiner. Joao is directed to an apparatus for providing healthcare information for payer and provider communication, including a central processing computer (see, e.g., Figure 2). Joao teaches that the central processing computer includes a database and provides a voluminous list of possible types of data that may be included in the database the central processing computer (see, e.g., paragraphs 0156-0180). Joao merely mentions, among a voluminous list of possible types of data that may be included in the database the central processing computer (see, e.g., paragraphs 0156-0180), that such data may include video and/or audio files for "dental training" (paragraph 0167). It is submitted that mere reference to "dental training" in the context of database storage information, without more, is insufficient to teach certifying dental practitioners to perform a dental procedure as recited in the current claims and disclosed throughout the specification.

For the reasons set forth above, the cited references fail to teach each element as set forth in independent claim 14 and, therefore, dependent claims 16-19, 21-22 and 29-30. Accordingly, removal of the rejection is respectfully requested.

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DeBruin-Ashton (U.S. Patent No. 6,014,629) in view of Joao (U.S. Publication No. 2002/0032583 A1) as applied to claim 14 above, and further in view of Tawil (U.S. Patent No. 5,225,976).

As discussed above, the combined DeBruin-Ashton and Joao references fail to teach each and every element of claim 14. DeBruin-Ashton, for example, fails to teach providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list. Joao fails to teach certifying a group of dental practitioners to perform a dental procedure.

The Tawil reference does not provide the teachings that are lacking from DeBruin and Joao. As such, the combination of De-Bruin-Ashton, Joao, and Tawil would fail to teach each and every element of the current claims. Accordingly, claim 15 is allowable over the cited references and removal of the rejection is respectfully requested.

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DeBruin-Ashton (U.S. Patent No. 6,014,629) in view of Joao (U.S. Publication No. 2002/0032583 A1) as applied to claim 14 above, and further in view of Falchuk *et al.* (U.S. Publication No. 2002/0152096 A1).

As set forth in the above discussion, the combined DeBruin-Ashton and Joao references fail to teach each and every element of claim 14. DeBruin-Ashton, for example, fails to teach providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list. Joao fails to teach certifying a group of dental practitioners to perform a dental procedure.

Falchuk does not provide the teachings that are lacking from DeBruin and Joao. As such, the combination of De-Bruin-Ashton, Joao, and Falchuk would fail to teach each and every element of the current claims. Accordingly, claim 20 is allowable over the cited references and removal of the rejection is respectfully requested.

Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DeBruin-Ashton (U.S. Patent No. 6,014,629) in view of Joao (U.S. Publication No. 2002/0032583 A1) and in view of Tawil (U.S. Patent No. 5,225,976), as applied to claims 14-15 above, and further in view of Kurzuis *et al.* (U.S. Patent No. 6,385,620 B1).

As set forth above, the combined DeBruin-Ashton and Joao references fail to teach each and every element of claim 14. DeBruin-Ashton, for example, fails to teach providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list. Joao fails to teach certifying a group of dental practitioners to perform a dental procedure. Claim 15 cannot be rendered obvious by the combination of DeBruin-Ashton, Joao, and Tawil because combined references do not teach each and every element of the current claims.

With respect to claims 23-25, Kurzuis does not provide the teachings that are lacking from DeBruin and Joao, or the combination of DeBruin-Ashton, Joao, and Tawil. As such, the combination of De-Bruin-Ashton, Joao, Tawil, and Kurzuis would fail to teach each and every element of the current claims 23-25. Accordingly, claims 23-25 are allowable over the cited references and removal of the rejection is respectfully requested.

Claims 46-49, 51-52 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tawil (U.S. Patent No. 5,225,976) in view of Falchuk *et al.* (U.S. Publication No. 2002/0152096 A1).

It is alleged that Tawil teaches tracking practitioner performance of medical procedures and maintaining a patient referral directory. It is further alleged that Falchuk teaches certifying a group of practitioners to perform a medical procedure, and that it would have been

obvious to combine the teachings of Tawil with Falchuk to produce the method of claim 46. Applicants respectfully disagree.

As set forth above, the teachings of Falchuk focus on a medical consultation support system designed to direct consultation between a primary care physicians and a specialist physicians, but fail to teach certifying a group of practitioners to perform a medical procedure. For example, the "accreditation" taught at paragraph 0030 of Falchuk and cited by the Examiner is distinguished from the "certifying" step of the current disclosure and claims. In particular, the continuing medical education (CME) "accreditation module" taught by Falchuk concerns recording and reporting of CME credits to a responsible accreditation authority (e.g., state medical board), based on the educational value, to the primary care physician, of the consultation with a specialist physician. The CME accreditation module of Falchuk, which concerns the awarding of CME credits by consultation of a primary care physician with a specialist physician, distinctly differs from the certifying of a group of practitioners to perform a particular medical procedure, as required by the current claims. As such, the cited references fail to teach each and every element of claim 46 because the references lack teaching certifying a group of practitioners to perform a medical procedure.

As such, the combination of Tawil and Falchuk would fail to teach each and every element of the current independent claim 46 and corresponding dependent claims 47-49, 51-52 and 58. Accordingly, claims 46-49, 51-52 and 58 are allowable over the cited references and removal of the rejection is respectfully requested.

Claims 50 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tawil (U.S. Patent No. 5,225,976) in view of Falchuk *et al.* (U.S. Publication No. 2002/0152096 A1) as applied to claims 46 and 58 above, and further in view of DeBruin-Ashton (U.S. Patent No. 6,014,629).

As discussed above, the combined Tawil and Falchuk references fail to teach each and every element of claim 46 and 58. For example, neither reference teaches certifying a group of practitioners to perform a medical procedure. Because DeBruin-Ashton does not provide the teachings that are lacking from Tawil and Falchuk, the references cited by the Examiner fail to



teach each and every element of the current claims 50 and 59. Accordingly, claims 50 and 59 are allowable over the cited references and removal of the rejection is respectfully requested.

Claims 53-54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tawil (U.S. Patent No. 5,225,976) in view of Falchuk *et al.* (U.S. Publication No. 2002/0152096 A1) as applied to claims 46 and 52 above, and further in view of Kurzuiz *et al.* (U.S. Patent No. 6,385,620 B1).

As discussed above, the combined Tawil and Falchuk references fail to teach each and every element of claim 46 and 52. Neither reference, for example, teaches certifying a group of practitioners to perform a medical procedure. Kurzuiz does not provide the teachings that are lacking from Tawil and Falchuk. As such, the references cited by the Examiner fail to teach each and every element of the current claims 53-54. Accordingly, claims 53-54 are allowable over the cited references and removal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: \_\_\_\_\_

7/8/05



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